In the Supreme Court of the United States

OCTOBER TERM, 1967

No. 741

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER, GEORGE NEWBOLT ROLINSON, PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

1. Petitioners filed an application with the United States Patent Office for a patent on phenoxacetylpenicillanic acid ("6-APA"), a reagent in a penicillin producing process (Pet. App. 30–31).[1] Petitioner's application was rejected by a Patent Office examiner as unpatentable because a patent on similar claims had already been granted to a Mr. Sheehan (Pet. App. 31). On June 21, 1965, the petitioners, pursuant to 35 U.S.C. 134, appealed the rejection of their claim to the Patent Office Board of Appeals (J.A. 22).

[1] "Pet. App." refers to the appendix to the petition for a writ of certiorari. "J.A." refers to the Joint Appendix in the court of appeals, a copy of which is being lodged with this Court.

282-073—67

Rather than prosecuting that appeal, petitioners sought to have the Patent Office initiate an "interference" proceeding pursuant to 35 U.S.C. 135.[2] Although recognizing that petitioners would have a right to contest the validity of the Sheehan patent through an intereference proceeding on the ground that their application alleged a date of conception earlier than the date of filing of the Sheehan application, the examiner found that the Sheehan application on which the patent was granted referred back to an earlier Sheehan application which clearly predated the date of invention claimed by petitioners.[3] The examiner ruled,

[2] 35 U.S.C. 135 authorizes the Commissioner of Patents to institute an administrative adversary proceeding, called an "interference," in which the question of priority between rival claimants is determined by a board of patent interferences.

[3] The examiner rejected petitioners' contention that the date of the original Sheehan application could not be used as a filing date because the reagent 6-APA, although mentioned in Sheehan's application, had not been made at that time. In so ruling, the examiner noted that Sheehan, who was present at the original experiment, testified that 6-APA had been produced and that the opinion evidence to the contrary offered by petitioners had not proved that it could not have been produced.

Contrary to petitioners' assertion (Pet. 14–16), the instant case does not raise any question with respect to the quantum of proof necessary to institute an interference. We agree with petitioners that Patent Office Rule 204(c), 37 C.F.R. 1.204(c), requires, as a precondition to the declaration of an interference, that an applicant must submit "prima facie" (not "conclusive") proof entitling him "to an award of priority relative to the effective filing date of the patentee." However, as we read the Patent Office examiner's decision in the instant case, the examiner merely intended to state that petitioners had not met the requirement of Rule 204(c) since, instead of establishing their own prior date of conception, petitioners attempted to attack the validity of Sheehan's earlier application. In any event, whether or not the examiner erred in this particular case in

that since the original Sheehan application showed the production of 6–APA, petitioners' application had been properly rejected as unpatentable and petitioners were not entitled to an interference proceeding. Finally, the examiner noted that the question of patentability was then on appeal and that the "decision of the Board in deciding patentability will also determine the question of the interference" (Pet. App. 38–42).

Petitioners then filed a petition with the Commissioner of Patents in which they sought to have the Commissioner direct the examiner to initiate an interference between their application and the Sheehan patent. The Commissioner of Patents, through the Acting Director of the Chemical Engineering Operation, denied this petition on the ground that the examiner's determination, that petitioners' claims were not patentable because of the earlier date of the original Sheehan patent, presented the issue, which the petition sought to raise, in a clear form that could be considered by the Patent Office Board of Appeals (Pet. App. 35–37).

Petitioners thereafter instituted this action in the United States District Court for the District of Columbia, purportedly under 28 U.S.C. 1361 and Section 10 of the Administrative Procedure Act, 5 U.S.C. 1009, seeking a judgment in the nature of mandamus (1) directing the Commissioner of Patents to institute an interference proceeding, and (2) staying further

---

applying the Patent Office Rules does not present any question of general significance warranting review by this Court. Moreover, the examiner's decision is subject to review by the Patent Office Board of Appeals. See *infra*, p. 4.

proceedings in petitioners' appeal before the Patent Office Board of Appeals until a final decision was obtained in the requested interference (J.A. 2–6, 20–24). The district court denied petitioner's motion for a preliminary injunction (J.A. 31), and granted the Commissioner's motion to dismiss because of lack of jurisdiction and failure to state a claim upon which relief can be granted (Pet. App. 34). The court of appeals unanimously affirmed on the ground that "the case is premature for judicial consideration, since there was no final agency action of the Patent Office" (Pet. App. 32).

2. The decision of the court of appeals is clearly correct and is not in conflict with any other decision. Review by this Court is thus not warranted.

As the court of appeals held, the Commissioner's refusal to order an interference proceeding "was only an interlocutory ruling in the consideration of [petitioners'] application," and "the courts will not consider the problem until there is a final agency decree rejecting [petitioners'] application for patent" (Pet. App. 32–33). Contrary to petitioners' assertion (Pet. 12–14), the administrative appeal provided by the Patent Office Board of Appeals, which petitioners have failed to prosecute, affords them a complete and adequate remedy at law. As the court of appeals concluded, petitioners "may still obtain a ruling from the Patent Office Board of Appeals that their claims are patentable. If their application is finally rejected, they will then be in a position to argue in court that re-

jection was the unlawful product of an improper and arbitrary procedure" (Pet. App. 33).[4]

For the foregoing reasons, the petition for a writ of certiorari should be denied.[5]

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

NOVEMBER 1967.

---

[4] The decision of the Patent Office Board of Appeals is reviewable by the Court of Customs and Patent Appeals or by a civil action in the United States District Court for the District of Columbia. 35 U.S.C. 141, 145.

Moreover, 35 U.S.C. 135 provides that "[w]henever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with any unexpired patent," he shall declare an interference. [Italics ours.] Since the Commissioner's determination is thus discretionary in nature, mandamus is not available to coerce the Commissioner to declare an interference. See *Ewing* v. *U.S. ex rel. Fowler Car Co.*, 244 U.S. 1.

[5] While petitioners' failure to obtain a final agency decision is dispositive, we also note the lack of merit in the contention that the Patent Office improperly decided the question of patentability first. The challenged procedure was recently and specifically approved by this Court in *Brenner* v. *Manson*, 383 U.S. 519, 528, fn. 12: "'The question as to patentability of claims to an applicant must be determined before any question of interference arises and claims otherwise unpatentable to an applicant cannot be allowed merely in order to set up an interference.'"

U.S. GOVERNMENT PRINTING OFFICE: 1967